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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/941,881 | 08/28/2001 | Lisa Saunder Boffa | JCW-0102 | 7839 |

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| EXAMINER | |
|---|---|
| PASTERCZYK, JAMES W | |
| ART UNIT | PAPER NUMBER |
| 1755 | 9 |

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/941,881 | Applicant(s) BOFFA ET AL. | |
|---|---|---|---|
| | Examiner J. Pasterczyk | Art Unit 1755 | |

*-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *10/18/01,1/3/02 and 1/7/03*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) *1-5 and 13-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-44* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5-7*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This Office action is in response to the IDS documents filed 10/18/01, 1/3/02, and 1/7/03.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, drawn to compounds, classified in class 556, subclass 33 inter alia.

II. Claims 6-12, drawn to a catalyst composition, classified in class 502, subclass 167.

III. Claims 13-44, drawn to an olefin polymerization method, classified in class 526, subclass various depending on the cocatalyst used.

3. The inventions are distinct, each from the other because:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a pigment for a UV-visible light filter, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, the former to filter UV or visible light, the latter to make polyolefins.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product, such as a Ziegler-Natta, metallocene, chromium oxide or metal imide catalyst.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Joseph Wang, Esq., on 8/6/02, a provisional election was made with traverse to prosecute the invention of group II, claims 6-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 and 13-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Claims 6-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the X and Z ligands being those specifically recited in the specification and claims, does not reasonably provide enablement for their being "any other moiety into which a monomer can insert" or "any other neutral coordinating ligand". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The language quoted is omnibus in its breadth, hence the claims rejected are considered to be themselves omnibus.

8. Claims 6-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, labeled l. 9 and 14, "any other moiety into which a monomer can insert" is vague and indefinite since it merely recites a function without the necessary chemical structure to apprise others of the scope of protection sought. Likewise, in l. 13 "any other neutral coordinating ligand" is also vague and indefinite since it lacks any structure necessary to carry out the recited function, leaving the actual identity of the ligand unknown to potential practitioners. In addition, "a monomer" is vague and indefinite; olefin monomers? Carbon monoxide monomers? Acrylate monomers? What specifically is the scope of protection sought here?

In claim 10 it is not clear that in the first compound recited the colon is supposed to be in its name.

In claim 11, "Lewis acids other than any of the foregoing" is in effect a negative limitation without bound, hence one of ordinary skill in the art would not be apprised of the scope of protection sought in this claim, thus the claim is indefinite.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 6, 7 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Davis et al., Macromolecules, vol. 33, no. 11, pp. 4039-4047 (2000) (hereafter referred to as Davis).

Davis discloses the invention as claimed (abstract, wherein alkyl bromide is a cocatalyst and the triamine ligand is the multidentate nitrogen-containing ligand.

11. Claims 6-9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Stibrany et al., WO 99/30822 (hereafter referred to as Stibrany).

Stibrany discloses the invention as claimed (abstract; p. 2, top; p. 4, bottom; p. 6, top and bottom structures with oxygen atoms; p. 7, both structures; p. 9, third paragraph).

12. Claims 6-9, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by van Baar et al., WO 00/35974 (hereafter referred to as van Baar).

van Baar discloses the invention as claimed (abstract; p. 4 middle to p. 6 top; p. 11, formula VI).

13. Claim 10 is allowable over the prior art of record. Its subject matter would have to be incorporated into the independent claim 6 and all formal rejections addressed in order to achieve allowability.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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2/29/04

Mark L. Bell
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